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10/695,205	10/28/2003	Bennett M. Richard	304-35713-US (D5407-216)	4513
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The time period for reply, if any, is set in the attached communication.

1	RECORD OF ORAL HEARING
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3	UNITED STATES PATENT AND TRADEMARK OFFICE
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6	BEFORE THE BOARD OF PATENT APPEALS
7	AND INTERFERENCES
8	
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10	Ex parte BENNETT M. RICHARD
11	and JOHN T. BROOME
12	
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14	Appeal 2008-1084
15	Application 10/695,205
16	Technology Center 3600
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19	Oral Hearing Held: October 23, 2008
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23	Before WILLIAM F. PATE, III, JENNIFER D. BAHR, and JOSEPH A.
24	FISCHETTI, Administrative Patent Judges
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28	ON BEHALF OF THE APPELLANT:
29	CEEVEN DOCENDI AEE ECOLUDE
30	STEVEN ROSENBLATT, ESQUIRE
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32	1200 Southwest Freeway, Suite 2150
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34	
35	
36	ALSO PRESENT:
37	CHADLES ODEENHUT
38	CHARLES GREENHUT
39	ERIC PICO
40	

1	The above-entitled matter came to be heard on Thursday, October 23,
2	2008, commencing at 9:04 a.m., at the United States Patent and Trademark
3	Office, 600 Dulany Street, Alexandria, Virginia, before Paula Lowery,
4	Notary Public.
5	<u>PROCEEDINGS</u>
6	
7	THE CLERK: Good morning. Calendar Number 31, Mr. Rosenblatt.
8	JUDGE PATE: Good morning, Mr. Rosenblatt. We've had the
9	opportunity to look at this case beforehand, so we're up to speed on the
10	technology. We'd like to hear your arguments for patentability.
11	MR. ROSENBLATT: Thank you, Judge. I appreciate it. Good
12	morning, everyone.
13	As I said in my brief, this is really a simple case and probably going to
14	be the shortest appeal brief ever filed. There's one issue, one claim, and one
15	reference at stake here, and this is Echols is the 102 rejection.
16	Echols teaches in great detail how to make a screen that's ultimately
17	used downhole in a well. He also talks about running it in oil and expanding
18	it.
19	Screen expansion downhole is frequently used to reduce the side of an
20	annular space around the screen so that control of production of things like
21	sand can be better initiated with less gravel filler around there. In fact, it
22	could eliminate the use of gravel altogether.
23	The claims in Echols because the issue of what does the preamble
24	mean here are also to a method of manufacturing, even though Echols
25	discusses what happens later.

1	The claim in question claim 1 doesn't talk about running the screen
2	that's already fabricated into the hole. It talks about how to make the screen.
3	Echols understands the expansion technology exists for screens, but
4	yet when he discusses his fabrication method his example shown in figure 3
5	is a weld 58. As explained in the application, welding is a bad thing if
6	you're going to expand downhole.
7	The use of screens could cause differential pressures on them if they
8	clog up, could put stresses on the end. Expansion to attach the filter
9	assembly to the base pipe is a more certain way of keeping them together.
10	Once they separate, you don't have any screening action at all.
11	So we went a few rounds during prosecution, which I'm sure you're
12	familiar with, and I could not convince this examiner that there is a
13	difference between a method of making something and a method of using
14	something.
15	A method of using something in a well bore requires you to run the
16	thing into the well bore. Otherwise, the method is useless. There's no
17	running it down the well bore in my claim 1.
18	My claim 1 focuses on how you attach the filter assembly to a base
19	pipe, which is part of the tubular string that goes in the hole. My preamble
20	says that just like Echols' preambles in all his claims says that, too.
21	These claims focus on how to make it, even though he talks about
22	how to run it. I'm trying to claim how to make it.
23	What's novel about this is the attachment is done by expansion,
24	eliminating the welding, eliminating a hazard of failure downhole. That's
25	pretty much it.
26	JUDGE PATE: Do you have any questions?

Appeal 2008-1084 Application 10/695,205

1 JUDGE FISCHETTI: No. 2 JUDGE PATE: Judge Bahr? 3 JUDGE BAHR: I don't think so. 4 JUDGE PATE: We have no questions. We're going to take this case 5 under advisement. 6 MR. ROSENBLATT: Thank you, sir. 7 JUDGE PATE: Thank you for your brief. 8 (Whereupon, the proceedings at 9:09 a.m. were concluded.)